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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,578	07/18/2003	Siegfried Sollner	32860-000559/US	2126
30596	7590	06/21/2006	EXAMINER	
HARNESSE, DICKEY & PIERCE, P.L.C.			GARLAND, STEVEN R	
P.O.BOX 8910			ART UNIT	
RESTON, VA 20195			PAPER NUMBER	
			2125	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,578

Applicant(s)

SOLLNER, SIEGFRIED

Examiner

Steven R. Garland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/18/03, 12/17/03, 7/2/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/17/03, 7/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 are pending.
2. Claims 1, and 3-8 objected to because of the following informalities: what the term EDP represents should be clarified. Appropriate correction is required.
3. The disclosure is objected to because of the following informalities: what EDP represents should be clarified in the abstract and in the disclosure paragraph 0008. It is assumed applicant intends it to represent electronic data processing.

Appropriate correction is required.

4. The drawings are objected to in the figure what the various black boxes represent should be explained such as element 10 "classification device", element 18, "selection device", etc. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For example claim 1 is directed to an abstract EDP-based method for creating a plant concept from a plurality of plant components, comprising: recording a desired specification of a technical plant using specification data; selecting, from a stored supply of plant component types, plant component types required for satisfying the desired specification of the technical plant, wherein the plant component types are selected based on the specification data; linking up the selected plant component types to form a plant configuration, wherein the linking up occurs in such a way that in principle, the plant configuration at least substantially satisfies the desired specification of the technical plant; and creating the plant concept from the plant configuration, wherein the plant component types are replaced by plant components, resulting in the plant concept describing an actually feasible technical plant.

The claim however fails to recite a useful, tangible, and concrete result to render the claim statutory but instead results in an abstract plant concept without any actual physical implementation of the plant concept. Similar comments apply to the remaining claims.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hodl 2003/0055742.

Hodl 2003/0055742 teaches computer aided planning of a plant, use of a configurator (abstract), user input of data (paragraph 0042), selecting specific components or products from stored data for the configuration (0043), use of an expert system (0010) or Artificial intelligence (0038), linking components (0038,0039) determining price and tender specification if desired (fig.3), automatic configuration or user selection of components (0043) , allowing the user to select components and assemble them to form a plant (0065-0068) and then alter the configuration if desired. See the abstract; figures (note figure 3); paragraphs 0001,0005,0007, 0008, 0013, 0015-0034, 0036,0038-0040, 0042, 0043, 0046, 0047, 0049, 0051-0062, 0065-0069,0087-0090, 0099, 0103-0108, and the claims. Note claim 1 and paragraphs 0103-0108.

8. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Phelps et al. 7,003,359.

Phelps et al. 7,003,359 teaches a method of process plant design (abstract), generating a general plan for a plant and then selecting components to generate a detailed plant plan (plant concept), linking the components in the plant and storing component data (col. 1, line 53 to col. 2, line 39; col. 3, lines 36-59), as well as generating a cost proposal. Phelps teaches recording specification data 17, use of classification and selection elements (tables in computer and computer implemented method) See the abstract; figures; col. 1, lines 18-36, col. 1, line 53 to col. 2, line 39; col. 3, line 36 to col. 4, line 56; col. 5, lines 48-67; col. 7, lines 26-43; col. 8, lines 4-58; col. 9, line 10 to col. 10, line 50; col. 13, line 22 to col. 14, line 51; col. 24, line 43 to col. 26, line 23; and the claims.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Phelps et al. 7,003,359.

Phelps et al. 7,003,359 teaches a method of process plant design (abstract), generating a general plan for a plant and then selecting components to generate a detailed plant plan (plant concept), linking the components in the plant and storing component data (col. 1, line 53 to col. 2, line 39; col. 3, lines 36-59), as well as

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generating a cost proposal. Phelps teaches recording specification data 17, use of classification and selection elements (tables in computer and computer implemented method) See the abstract; figures; col. 1, lines 18-36, col. 1, line 53 to col. 2, line 39; col. 3, line 36 to col. 4, line 56; col. 5, lines 48-67; col. 7, lines 26-43; col. 8, lines 4-58; col. 9, line 10 to col. 10, line 50; col. 13, line 22 to col. 14, line 51; col. 24, line 43 to col. 26, line 23; and the claims.

Phelps while teaching computer implementation does not specifically state that the computer implements the required classification and selection devices.

It would have been obvious to one of ordinary skill in the art to modify Phelps and have a computer, in the computer implemented system, perform the required classification and selection functions using software so that the system could generate the detailed plant plans from the selected components and fulfill its intended function of plant design without requiring additional physical structure and thereby reduce the cost. This would also prevent the user from overlooking a component which could be replaced by a standard previously designed component to thereby lower the cost to the plant purchaser and prevent redesign of an previously designed component.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barck et al. 7,003,548 is of interest in system design and Lynch et al. 2006/0100829 is of interest in configuring systems based on user needs.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Garland whose telephone number is 571-272-3741. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 571-272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRG

Steven R Garland
Examiner
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A handwritten signature in black ink, appearing to read 'L. Picard', with a stylized flourish at the end.

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100